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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 36

Application Number: 09/488,079

Filing Date: January 20, 2000

Appellant(s): David R. Montague

A. John Pate

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 27, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 2, 5-12, 15-19, 22, and 24-28 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,153,842	Dlugos Sr. et al	10-1992

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 5-12, 15-19, 22, and 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Dlugos Sr. et al (5,153,842).

Claims 1, 11, 18, and 24: Dlugos discloses a method and apparatus for attaching product labels comprising:

a. Affixing a label to a product surface (col 5, lines 48-56);

b. Configuring the label to provide information corresponding to at least the product and/or source of product (col 3, lines 19-23 and 53-57); and

c. Coupling a computer readable medium containing computer executable instructions (i.e program) to the label (col 3, lines 39-42 and col 5, lines 48-59).

While it is not explicitly disclosed that the computer executable instructions on the computer readable medium are executable by a computer of the purchaser of the product, it is noted that since Dlugos discloses that the instructions are executed on one or more computers (e.g. shipper's computer) that it is inherent that they would also be executable on the purchaser's computer or on any other computer. The actual type of instructions contained on the medium, whether a game program, assembly or operating instructions for the product, an infomercial for the product or for another product, or any other kind of program, does not alter the claimed apparatus of a computer readable medium containing computer readable instructions attached to the outside of a product using a label. Thus no patentable weight is given to how the computer instructions are being used after removal from the product or by whom.

Claims 2, 12, and 19: Dlugos discloses an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and further discloses the information is printed on the label (col 3, lines 19-23).

Claims 5, 15, and 22: Dlugos discloses an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and further discloses the computer readable medium containing information pertaining to product facts, source facts, data gathering interface, and many other types of information for use by the receiver, sender, and/or shipper (col 9, lines 49-62).

Claim 6: Dlugos discloses an apparatus for attaching product labels as in Claim 1 above, and further discloses that the label may be attached in various ways to a wide variety of products (col 5, line 48 - col 6, line 23).

Claim 7: Dlugos discloses an apparatus for attaching product labels as in Claim 6 above, and further discloses placing the label onto the product in a manner which protects the label from damage (col 5, lines 48-56).

Claims 8 and 16: Dlugos discloses an apparatus for attaching product labels as in Claims 1 and 11 above, and further discloses the label is a hang tag enclosing the computer readable medium (col 5, lines 48-56).

Claims 9 and 17: Dlugos discloses an apparatus for attaching labels as in Claims 1 and 11 above, and further discloses that the computer readable medium includes a printed medium or an electromagnetic medium (col 3, lines 19-23 and 39-52).

Claim 10: Dlugos discloses an apparatus for attaching product labels as in Claim 9 above, and further discloses that the computer readable medium is formatted as a bar code or embedded chip (col 3, lines 12-13, col 4, lines 52-57, and col 4, line 67 - col 5, line 8).

Claim 25: Dlugos discloses a method for attaching product labels as in Claim 24 above, and furthe discloses that the product is packaged with a "clear plastic film or packing material containing air bubbles (col 5, lines 49-51).

Claim 26: Dlugos discloses a method for attaching product labels as in Claim 24 above, and furthe discloses that the label is attached to the outside of the product using a flexible member (i.e. the label is a tag)(col 5, line 60 - col 6, line 2).

Claims 27 and 28: Dlugos discloses an apparatus for attaching product labels, comprising:

a. A label affixed to a product surface at the source of the product (col 5, lines 48-56);

b. Configuring the label to provide advertising information corresponding to at least the product and/or source of product (col 3, lines 19-23 and 53-57); and

c. Coupling a computer readable medium containing computer executable instructions (i.e program) to the product by the label (col 3, lines 39-42 and col 5, lines 48-59).

While it is not explicitly disclosed that the computer executable instructions on the computer readable medium are executable by a computer of the purchaser of the product, it is noted that since Dlugos discloses that the instructions are executed on one or more computers (e.g. shipper's computer) that it is inherent that they would also be executable on the purchaser's computer or on any other computer. The actual type of instructions contained on the medium, whether a game program, assembly or operating instructions for the product, an infomercial for the product or for another product, or any other kind of program, does not alter the claimed apparatus of a computer readable medium containing computer readable instructions attached to the outside of a product using a label. Thus no patentable

weight is given to how the computer instructions are being used after removal from the product or by whom.

It is also inherent that since the label in Dlugos is on the outside of the product, it is viewable by the prospective purchaser or anyone else who looks at the product.

Claims 3, 4, 13, 14, 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dlugos Sr. et al (5,153,842).

Claims 3, 13, and 20: Dlugos discloses an apparatus for attaching product labels as in Claims 2, 12, and 19 above, but does not explicitly disclose that the printed information is contained in a selection o color on the label. Official Notice is taken that it is old and well known within the marketing arts to use color to differentiate between various labels and tags; such as a clothing store using pink hang tags to indicate that the garment's size is Small, light blue hang tags to indicate that the garment's size is Medium and green hang tags to indicate that the garment's size is Large. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use labels of various colors in Dlugos. One would have been motivated to use labels of different color in order to facilitate quick and easy identification of the product or product manufacturer by the merchant, the shipper, and the customer (e.g. a blue label for a product made by IBM, whose nickname is "Big Blue").

Claims 4, 14, and 21: Dlugos discloses an apparatus for attaching product labels as in Claims 1, 11, and 18 above. While Dlugos prefers that the label is the same size and shape as a credit card, it is also disclosed that the label "may be of an overall shape or size different from the standard credit card" (col 6, lines 11-23). However, Dlugos does not explicitly disclose using a trademark symbol on the label to

identify the product or the source of the product. Official Notice is taken that it is old and well known within the marketing arts to use trademark symbols to identify both products and product sources; indeed, that is the purpose for registering trademarks. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a trademark symbol on the label in Dlugos. One would have been motivated to include a trademark symbol on the label in order to facilitate quick and easy identification of the product and its source.

Claim 23: Dlugos discloses an apparatus for attaching product labels as in Claim 18 above. While various methods of attaching the label to the product are disclosed, including inserting the label into a small pouch, using clips or brackets, etc., it is not explicitly disclosed that the opening into which the labe is inserted penetrates all the way into the interior of the product. However, it would have been obvious that such a method of attachment could be used, depending upon the actual product, of course. One would have been motivated to use this or other methods to attach the label to the product in order to prevent or reduce the likelihood that the label would become detached during shipping or handling as discussed by Dlugos.

(11) Response to Argument

The Appellant argues that the reference does not disclose that the data stored on the label is computer executable instructions, nor that the instructions can be executed by the purchaser's computer (pages 5 and 6). The Examiner submits two responses to these arguments. First, the Examiner notes that even if Dlugos only disclosed that data was stored on the label instead of computer executable instructions, the claims never utilize the computer executable instructions in any way. Thus, the type of data being stored on and transported via the label, whether graphical images, textual data, computer

executable instructions, or any other type of electronic data, does not affect the claimed steps. Second, as admitted by the Appellant, Dlugos does disclose operating software (computer executable instructions) are stored on the label, along with other data. Dlugos also discloses that the operating software on the label is activated by an external terminal to perform at least read and write functions (col 5, lines 43-47 and col 7, line 31- col 8, line 5). Thus, the stored computer executable instructions are being executed by the external terminal. The Examiner notes that the claimed invention does not indicate that the computer executable instructions are downloaded to the purchaser's computer, only executed by it. As discussed in the rejection above, the ownership of the external terminal, whether owned by the purchaser, a user which received the item at no cost (e.g. as a gift), the merchant, a shipper, or some other party, does not affect the claimed steps. Thus, Dlugos does disclose computer executable instructions stored on the label which are executed by an external computer (which could be owned by a purchaser or any other entity).

The Appellant also argues that Dlugos does not disclose "coupling a label's identifying informatio (e.g. trademark or tradedress colors, shapes, images, words, etc) to a computer readable medium containing executable instructions directed to the computer of a purchaser" (page 9). The Examiner notes that these claims were rejected under 35 U.S.C. 103 over a combination of Dlugos and Official Notice that it was old and well known to use various colors or a trademark to identify the product, manufacturer, retailer, etc (which the Appellant has not heretofore contested as not being old and well known). Dlugos discloses that the label surface contains such information as the name of the owner or issuer of the label (col 3, lines 19-21) and that it is known to include such other information printed on a label as the "name and address of sender" (col 1, lines 9-27). Dlugos also discloses that the label "may be of an overall shap or size different from the standard credit card shape and size" (col 6, lines 11-14). Based on these two

disclosures that the widespread use of colors and trademarks to identify products, manufacturers, and retailers within our society, it would have been obvious to one having ordinary skill in the art to use these conventions when designing the label in Dlugos. Furthermore, the Examiner notes that the size, shape, or color of the label does not affect the overall functionality of the label as claimed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JWM
December 22, 2003

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